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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,747	06/20/2005	Hiroshi Yokota	050344	5871
23850 7590 12/03/2008 KRATZ, QUINTOS & HANSON, LLP 1420 K Street, N.W. Suite 400 WASHINGTON, DC 20005				
EXAMINER TURNER, SONJI LUCAS				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/539,747

Applicant(s)

YOKOTA ET AL.

Examiner

SONJI TURNER

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Elonon '789 (US Patent 5,711,789).

Regarding claim 1, Elonon '789 teaches a gas-liquid separator for gas-liquid separation performed by centrifugal force of an impeller mounted on a shaft which rotates in a casing with a discharge impeller part; a discharge outlet of the casing disposed in a position opposite the discharge impeller part; another axial end of the impeller; and exhaust outlet of the casing disposed in a position opposite the impeller part; a vacuum means connected to the exhaust outlet; and a suction inlet of the casing disposed in a position between the discharge outlet and the exhaust outlet (fig. 3; col. 6, lines 38-67; col. 7, lines 38-54; col. 8).

Regarding claim 2, Elonon '789 teaches a cleaning fluid inlet is provided near the shaft sealing of the casing where the rotating shaft penetrates (fig. 3; col. 7, lines 14-17).

Regarding claims 3 and 4, Elonon '789 teaches the inlet to the casing formed to a flow path inside the casing (fig. 3; col. 7, lines 55-60).

Regarding claims 5 and 6, Elonon '789 teaches a member which prevents the direct penetration of liquid near the rotating shaft (fig. 3; col. 8, lines 47-52).

Regarding claims 7 and 8, Elonon '789 teaches an impeller with at least one cylindrical member coaxially attached (fig. 3).

Regarding claims 9-11, Elonon '789 teaches at least one of fluid throttle means, heating means, and accumulation means in the passage of the suction inlet (fig. 3). An accumulation space is located upstream of the impeller.

Regarding claims 12-14, Elonen '789 teaches a cavitation causing means in the passage (fig. 3).

Regarding claims 15-17, Elonen '789 teaches protection means in the exhaust passage from the exhaust outlet to the vacuum means (col. 9, line 1-5).

Regarding claims 18-20, Elonen '789 teaches that at least a portion of the discharged fluid from the discharge outlet is returned to the suction inlet (fig. 3; col. 7, lines 14-17).

Response to Remarks

Applicant's remarks filed August 25, 2008 have been fully considered but are not persuasive. Figure 3 of Elonen '789 is a schematic view of an entire system that relates to a method and an apparatus for separating fluid. Elonen '789 teaches each of the structural limitations recited in instant claim 1. Applicant's remark on page 8 where claim 1 requires "the impeller being formed to slide on the inner wall of the casing" relates to an intended use of the impeller, as a physical structure for the impeller has not been given. Intended use has been continuously held not to be germane to determining the patentability of the apparatus, *In re In re Finsterwalder*, 168 USPQ 530 (CCPA 1971). Purpose to which apparatus is to be put and expression relating apparatus to contents thereof during intended operation are not significant in determining patentability of an apparatus claim, *Ex parte Thibault*, 164 USPQ 666 (PTO Board of Appeals 1969). Inclusion of the material worked upon by a structure being claimed does not impart patentability to the claims, *In re Otto et al.*, 136 USPQ 458 (CCPA 1963). A recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the structural limitations of that claimed, *Ex parte Masham*, 2 USPQ 2d 1647 (PTO Board of Appeals 1987). In

apparatus, article, and composition claims, intended use language must result in a structural difference to patentably distinguish over the prior art. See MPEP § 2112 and *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997).

Applicant's remarks, see page 7, with respect to the specification and claim 9 have been fully considered and are persuasive. The objections of the specification and claim 9 have been withdrawn.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonji Turner whose telephone number is 571-272-1203. The examiner can normally be reached on Monday - Friday, 10:00 am – 2:00 pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on 571-272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Duane S. Smith/
Supervisory Patent Examiner, Art Unit
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12/01/08